

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST AUGUST HAHNE, FRANZ KNOFF
and HERMANN KUNZIG

Appeal No. 2003-1915
Application No. 09/423,232

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 82-103, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a device for compressing a stack of objects such as sheets of paper. An understanding of the invention can be derived from a reading of exemplary claim 82, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hahne <u>et al.</u> (Hahne '546)	5,868,546	Feb. 9, 1999
Hahne <u>et al.</u> (Hahne '257)	6,015,257	Jan. 18, 2000 (filed Oct. 5, 1995)
Hahne <u>et al.</u> (Hahne '651)	6,102,651	Aug. 15, 2000 (filed Apr. 16, 1996)

Claims 82-90 and 93-103 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hahne '651 in view of Hahne '257.¹

Claims 82, 91, 92 and 103 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hahne '546 in view of Hahne '651 and Hahne '257.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 19) and the final rejection (Paper No. 16) for the examiner's complete

¹Claim 93 was not included in the statement of either of the rejections. Since claim 93 depends from claim 89, we shall consider it as inadvertently being omitted from this one of the rejections.

reasoning in support of the rejections, and to the Brief (Paper No. 18) and Reply Brief (Paper No. 20) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

As explained on page 1 of the Brief, the appellants' invention comprises a device that compresses a stack of objects by means of pressing plates in which at least one charging electrode is integrated into a pressing plate in order to enhance the compression of the stacked objects by transferring an electrical charge thereto. To this end, independent claim 82 recites, inter alia, two end elements opposite one another which contact the ends of the stack of objects to compress the stack, and at least one charging electrode comprising "a metal plate which contacts an end of the stack to transfer a charge to the stack and is part of one of the two end elements."

In the first of the two rejections of independent claim 82, it is the examiner's view that the subject matter recited therein would have been obvious to one of ordinary skill in the art in view of the combined teachings of Hahne '651 and Hahne '257. In arriving at this conclusion, the examiner has found that all of the subject matter recited in claim 82 is disclosed or taught by Hahne '651 except for "the specific teaching of at least one

charging electrode located in one of the pressing elements.” However, the examiner has taken the position that it would have been obvious to add such a feature to the apparatus of Hahne ‘651 in view of the teachings of Hahne ‘257 “in order to further improve the locking effect between the objects of the stack.” See Paper No. 16, pages 3 and 4. The appellants argue that the electrode disclosed in Hahne ‘257 to which the examiner refers is a non-contact electrode that is neither installed in a pressing element nor in contact with the stack of objects, and therefore no suggestion exists to modify Hahne ‘651 in the manner proposed.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Applying this guidance to the situation at hand leads us to agree with the appellants that this rejection of claim 82 is defective and should not be sustained. Our reasoning follows.

Hahne '651 discloses a machine for compressing a stack of objects comprising two opposed side walls and two pressing end elements. While the Hahne '651 apparatus also includes electrodes located at the side walls to charge the stack, it does not disclose an electrode positioned at the end of the stack, much less an electrode that is a metal plate in contact with the stack and which is part of one of the pressing elements.

In Hahne '257 an electrode 13 is located "above stack 6 [of the objects]" (column 2, line 20, emphasis added). As shown in Figure 2, electrode 13 is spaced from the top of the stack of objects, and there is no teaching in this reference that electrode 13 is in contact with the stack. This being the case, it is our view that no suggestion is present in Hahne '257 that would have motivated one of ordinary skill in the art to utilize a metal plate as a charging electrode, to place it in contact with the end of the stack, and to do so by making it part of one of the two end pressing elements, as required by claim 82.

The combined teachings of Hahne '651 and Hahne '257 thus fail to establish a prima facie case of obviousness with respect to the subject matter recited in independent claim 82, and we will not sustain the rejection of claim 82 or, it follows, of claims 83-90 and 93-103, which depend therefrom.

We reach the same conclusion with regard to the rejection of claim 82 on the basis of Hahne '546 in view of Hahne '651 and Hahne '257. In this case, the examiner admits that Hahne '546 fails to disclose or teach the two opposed side walls and a charging electrode which is a metal plate that contacts the end of the stack and is located in one of the pressing elements. While it is true that Hahne '651 discloses two opposed side walls in addition to the end elements, Hahne '651 does not disclose or teach positioning a charging electrode at the end of the stack. Such an arrangement is present in Hahne '257 but, as we have explained above, it is a non-contact electrode and fails to meet any of the requirements for the electrode that are set forth in claim 82. Thus, as was the case with the other rejection, the combined teachings of the applied references fail to establish a prima facie case of obvious with regard to independent claim 82. The rejection of claim 82 and dependent claims 91, 92 and 103 is not sustained.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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